UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,712	12/05/2003	Tsuyoshi Masuda	3071	9956

7590 04/26/2006

WALTER A. HACKLER, Ph.D.
PATENT LAW OFFICE
SUITE B
2372 S.E. BRISTOL
NEWPORT BEACH, CA 92660-0755

EXAMINER	
NORDMEYER, PATRICIA L	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/728,712	MASUDA ET AL.	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections/Objection

1. The objection to claims 1 and 7 in the office action dated December 7, 2005 is withdrawn due to Applicant's amendments in the response dated February 28, 2006.

2. The 35 U.S.C. 103 rejection of claims 1, 3 – 7 and 9 – 11 over Nibling, Jr. in view of Shibata et al. in the office action dated December 7, 2005 is withdrawn due to Applicant's amendments in the response dated February 28, 2006.

3. The 35 U.S.C. 103 rejection of claims 2 and 8 over Nibling, Jr. in view of Shibata et al. and Patton et al. in the office action dated December 7, 2005 is withdrawn due to Applicant's amendments in the response dated February 28, 2006.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments to the claims contain the language

"without a release coating", and the area as referenced in the response, Page 8, line 5, provides no support for the amendment.

6. Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no description in Applicant's specification as to how the silicone liners are constructed without involving coatings on a base layer.

Correction/clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3 – 7 and 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nibling, Jr. (USPN 5,472,755) in view of Shibata et al. (USPN 4,633,276), Miro (USPN 3,616,109) and Haase et al. (USPN 6,797,333).

Nibling, Jr. discloses a runnable splice (Column 1, lines 6 – 7) comprising a first

imprintable label stock having a first face layer of paper (Column 6, lines 9 – 16), a first liner and a pressure sensitive adhesive disposed there between, the first label stock having a first end disposed transverse to a length of the first label stock; a second imprintable label stock having a second face layer of paper, a second liner and a pressure sensitive adhesive disposed there between, the second label stock having a second end disposed transverse to a length of the second label stock, the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap there between (Column 5, lines 32 – 47); a third imprintable label disposed over said splice gap and adhered to both the first and second face layers for enabling printing over said splice gap (Column 5, lines 48 – 54 – since the tape contains a carrier layer and pressure sensitive adhesive, it is inherent that it would also be printable); and a splice tape disposed over said splice gap (Column 5, lines 59 – 60), which is disposed at an angle of about 0 degrees transverse to a longitudinal axis of the first and second stock (Figure 2), and adhered to both the first and second silicone liners (Column 3, lines 60 – 63), the adherence of said splice tape to silicone liner enabling the removal of the liners from the face layer without separating the liners from one another (Column 5, line 65 to Column 6, line 8) as in claims 1, 3 - 5, 7, 9 and 10. Regarding claims 6 and 11, the splice tape has a width that is equal the third external label width (Figure 2). However, Nibling, Jr. fails to disclose the imprintable label stock having a layer of thermal paper, the splice tape having a width greater than said third imprintable label in order to insure bonding between the third printable layer and the first and second layers and silicone liners without a release coating.

Shibata et al. teach a thermosensitive recording label (Column 2, line 67) having a thermosensitive color-forming layer disposed on one side of the substrate (Column 2, line 68 to Column 3, line 11) made of paper (Column 4, lines 3 – 5) and an adhesive layer covered with a silicone release liner (Column 5, lines 21 – 24) for the purpose of forming a label that is used on a variety of products without fading of the color formations over long periods of time (Column 1, lines 37 – 39).

Miro teaches a splice for pressure sensitive adhesive stock (Column 1, lines 59 – 62), wherein the splice tape (Figure 1, #2) has a width greater than said labels (Figure 1, #12) in order to insure bonding between the third printable layer and the first and second layers (Figure 1) for the purpose of forming a continuous roll is available for continued processing (Column 1, lines 7 – 9).

Haase et al. teach silicone liners without a release coating, where in the silicone liners are formed from a layer of liquid silicone that has be cured with UV radiation (Abstract, lines 1 – 6) for the purpose allowing the adhesive material to be separated from the liner material (Abstract, lines 8 – 10).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the thermal paper, a large splice tape and silicone liners in Nibling, Jr. in order to form a label that is used on a variety of products without fading of the color formations over long periods of time as taught by Shibata et al., form a continuous roll is available for continued processing as taught by

Miro and to allow the adhesive material to be separated from the liner material as taught by Haase et al.

9. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nibling, Jr. (USPN 5,472,755) in view of Shibata et al. (USPN 4,633,276), Miro (USPN 3,616,109) and Haase et al. (USPN 6,797,333) as applied to claims 1, 3 – 7 and 9 - 11 above, and further in view of Patton et al. (USPN 5,530,517).

Nibling, Jr., as modified with Shibata et al., Miro and Haase et al., discloses a runnable splice (Column 1, lines 6 – 7) with a splice gap having a width of 0.008 to about 0.06 inches (Column 3, lines 23 – 28) as stated above. However, Nibling, Jr. fails to disclose the third label having a width of between 0.5 inches and about 3 inches.

Patton et al. teach a printable label (Column 6, lines 5 – 7) for using for splicing together end roll materials having a width from 0.5 inches to 1 inches (Column 6, lines 15 – 20) for the purpose of splicing two rolls of material together while presenting information about the rolls of material (Column 2, line 65 to Column 3, line 2).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the label with the desired width in the splicing operation of Nibling, Jr. and Shibata et al. in order to splice two rolls of material together while presenting information about the rolls of material as taught by Patton et al.

Response to Arguments

10. Applicant's arguments with respect to claims 1 - 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/20/06